

Application No. 10/734,513
Office action dated May 2, 2007
Amendment and Response dated July 30, 2007

REMARKS

Claims 1, 2, 4-6, 9-18, 23-28, 32, and 35-68 are pending and stand rejected. Claims 5, 6, 17, 35, 36, 37, 46, 47, and 56 are amended for clarity. No new matter has been introduced.

Applicants thank the Examiner for the courtesy of an in person interview conducted July 19, 2007. Applicants confirm that the substance of the July 19, 2007 Interview ("the Interview") is as stated in the Interview Summary, PTOL-413, which was provided at the conclusion of the Interview.

Applicants have reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicants submit that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

Information Disclosure Statement

Applicants are submitting herewith an Information Disclosure Statement including a concise explanation of the relevance of DE 3908029. Consideration of the reference is respectfully requested.

Rejections Under 35 U.S.C. § 112

Claims 5, 6, 17, 35-37, 46, 47, and 56 stand rejected under 35 U.S.C. § 112, second paragraph, for failure to particularly point out and distinctly claim the invention. These claims are amended herein to address these rejections.

No disclaimer or narrowing of claimed subject matter is intended or effected by the amendments to claims 5, 6, 17, 35-37, 46, 47, and 56. Rather, the claims have only been amended to clarify their language. For example, claims 5 and 17 have been amended to set the clause "and therefore of said keys" apart from the remainder of the claim in order to clarify that, because the key ID tags are attached to the vehicle keys as recited in claim 1, detecting the presence or absence of the key ID tags necessarily also detects the presence or absence of the keys themselves.

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Applicants submit that these amendments overcome the rejections under section 112.

Rejections Under 35 U.S.C. § 103

Claims 16-18, 23-26, 32, 35, 40, 41, 43, 45, 46, 53-56, 58, 60-62, and 65 stand rejected under 35 U.S.C. § 103 as obvious over United States patent no. 6,611,232 to Wunderlich et al. ("Wunderlich") in view of United States patent no. 6,737,961 to Flick ("Flick"). Claims 1, 2, 4-6, 9-15, 27, 28, 37-39, 42, 44, 47-52, 57, and 63-64 stand rejected as obvious over Wunderlich in view of Flick and United States patent application publication no. 2002/0147981 to Ohta et al. ("Ohta"). Claims 36, 59, and 66-68 stand rejected as obvious over Wunderlich, Flick, and Ohta, further in view of United States patent no. 5,373,282 to Carter ("Carter"). Applicants respectfully submit that the Wunderlich and Flick cannot properly be combined, and that the rejections under 35 U.S.C. § 103 should therefore be withdrawn.

To establish a prima facie case of obviousness, there must be some suggestion or motivation to combine one or more references, with a reasonable expectation of success, to teach or suggest each and every claimed limitation. MPEP § 2142. Though it is no longer required that motivation be found in the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art, the underlying Graham factual inquiries remain unchanged. KSR Int'l Co. v. Teleflex Inc., 500 U.S. ____ (2007). Nor did KSR alter the principle that, where the prior art teaches away from a particular combination of elements, the combination is more likely to be non-obvious. That is, even though KSR permits the application of common sense in combining references, KSR does not alter the fact that common sense would not motivate one of ordinary skill to make an explicitly criticized or otherwise undesirable combination, or to proceed contrary to conventional wisdom and clearly established industry trends.

Wunderlich teaches vehicle mounted lock boxes, while Flick teaches a single storage device for a plurality of vehicle keys. Wunderlich and Flick are, therefore antithetical to each other. While it is true that a mere disclosure of alternative designs

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does not teach away from a claimed invention, a reference does teach away when it “criticize[s], discredit[s], or otherwise discourage[s]” the claimed invention. E.g., In re Fulton, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (citing In re Gurley, 27 F.3d 551 (Fed. Cir. 1994)); see also Medicem, S.A. v. Rolabo S.L., 437 F.3d 1157, 1165 (Fed. Cir. 2006); Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 885 (Fed. Cir. 1998) (“A prior art reference may be considered to teach away when ‘a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant’”). In the instant case, Flick explicitly disparages vehicle mounted lock boxes as “a security risk” and for failing to provide accountability of vehicle keys, criticisms that clearly teach away from the claimed invention. Flick, col. 1, lines 15-23.

Moreover, Flick is instructive for its teachings concerning the level of ordinary skill in the art. Flick was filed a mere four months before the present application, and thus is likely instructive of the state of the art at the time of Applicants’ invention. As discussed during the Interview, at the time of Applicants’ invention, Applicants believe the art was moving away from vehicle-based systems, such as disclosed in Wunderlich, towards centrally-located systems, such as disclosed in Flick. This trend was driven by the very reasons vehicle-based systems are criticized in Flick (e.g., security risks and lack of accountability).

By definition, one of ordinary skill in the art follows industry trends; it is a touchstone of inventorship and a hallmark of non-obviousness to “think outside the box” and proceed contrary to accepted wisdom. In re Hedges, 783 F.2d 1038 (Fed. Cir. 1986); see also MPEP § 2145(X)(D)(3).

In light of the explicit teaching away in Flick and the perceived industry trend at the time of Applicants’ invention, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to combine Wunderlich and Flick without the improper application of hindsight in light of the present invention. E.g., In re Mills, 916 F.2d 680 (Fed. Cir. 1990); see also In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular findings must be made as to the reason the skilled artisan, *with no knowledge of the claimed invention*, would have selected these components for

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combination in the manner claimed.") (emphasis added); MPEP § 2145(X). Having established that one of ordinary skill in the art would not have been motivated to combine the references asserted by the Examiner, Applicants respectfully request reconsideration and withdrawal of all rejections under 35 U.S.C. § 103.

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CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and request that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension of time is believed necessary for this paper to be considered timely. If such an extension is deemed necessary, Applicants hereby petition therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 81911-0002.

Respectfully submitted,

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